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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,629	06/22/2001	Vipul Bansal	JP920010121US1	7402

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EXAMINER

AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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11/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/887,629	Applicant(s) BANSAL ET AL.	
	Examiner OLABODE AKINTOLA	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,8,9,13-15,19,21,22,26,27,31-33,37,39,40,44,45 and 49-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,8,9,13-15,19,21,22,26,27,31-33,37,39,40,44,45 and 49-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-4, 8-9, 13-15, 19, 21-22, 26-27, 31-33, 37, 39-40, 44-45 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pathak (US 20020016760) ("Pathak") in view of Tannenbaum, J ("Web Sites Help Small Companies Open Internet Stores--E-Business Service Providers Offer Inexpensive Way to Try Something New", Wall Street Journal, New York, N.Y.: April 25, 2000) (hereinafter referred to as "Tannenbaum").

Re claims 1, 19 and 37: Pathak teaches a method for enabling the online determination of end to end costs during an online ascending or reverse auction, said method comprising: maintaining an online database of costs associated with each significant cost element in order to compute said

Art Unit: 3691

end to end costs for goods and services offered by an offerer and bid upon by a bidder (sections 033); receiving a first online bid to buy or sell said offered goods and services from a first bidder (sections 033); updating said online database of costs related to said first online bid and calculating a first bid's end to end costs related to said first online bid (sections 033); receiving a second online bid to buy or sell said offered goods and services from a second bidder (sections 033); updating said online database of costs related to said second online bid and calculating a second bid's end to end costs related to said second online bid (sections 033); if, in an ascending auction, said second bid's end to end costs result in a higher payout to said offerer than the first bid's end to end costs, then accepting said second bid, else accepting said first bid (section 0009, 0010, 0014, claim 3 (f.iv-f.v and d.)); and if, in a reverse auction, said second bid's end to end costs result in a higher cost to said offerer than the first bid's end to end costs, then accepting said first bid, else accepting said second bid (section 0009, 0010, 0014, claim 6 (f.iv-f.v and d)).

Pathak does not explicitly teach the method is implemented by an online intermediary providing facilities as a service free of charge. Tannenbaum teaches an online intermediary (entity hosting) providing facilities as a service free of charge (pages 1-2). It would have been obvious to one ordinary skill in the art at the time of the invention to modify Pathak to have an intermediary provide this service for free in exchange for placing advertisement on the website.

Re claims 3, 21 and 39: Pathak teaches wherein said each significant cost element includes any of shipping and handling costs, logistics management costs, taxes, finance costs, commissions, duties, insurance, regulatory and statutory-related costs, and information costs (section 0033).

Art Unit: 3691

Re claims 4, 22 and 40: Pathak teaches wherein databases, which provide information for updating said online database of costs, are associated with said offerer, said bidder or by a third party (section 0033, fig. 1).

Re claims 8-9, 13-14, 26-27, 31-32, 44-45 and 49-50: Pathak teaches an online ascending and reverse auctions; minimum/maximum qualifying bid (abstract, sections 0009, 0010, 0014, 0033, claim 3 (f.iv-f.v and d.), claim 6 (f.iv-f.v and d)).

Re claims 15, 33 and 51: Pathak teaches wherein updated offers are shown to potential bidders after online computation of said end to end cost (section 0013)

Response to Arguments

Applicant's arguments filed 11/18/2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the Phatak reference can not be combined with the Tannenbaum reference, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Art Unit: 3691

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation has been expressly articulated by the Examiner in the rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3691

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691